

REMARKS

This document is filed in reply to the office action dated May 6, 2003 ("Office Action"). Applicants have amended claim 1 at the Examiner's request to correct informalities. No new matter has been introduced.

Claims 1, 3-5, 7-9, and 11-37 are pending. Claims 4-5, 7-9, and 12-22, drawn to non-elected inventions, have been withdrawn. Among the non-withdrawn claims, claims 1 and 11 have been examined. See the Office Action, page 2, last line. Claims 3 and 23-37, contrary to the Examiner's statement on the Summary sheet, have never been withdrawn from consideration.

Reconsideration of claims 1 and 11 and consideration of claims 3 and 23-37 are respectfully requested.

Objection against claim 1

The Examiner objected to claim 1 for informalities. See the Office Action, page 3, lines 1-4. Applicants submit that the ground for objection has been overcome by the above amendments.

Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1 and 11 for lacking novelty on various grounds. Applicants traverse the Examiner's grounds for rejection as follows.

I

The Examiner rejected claims 1 and 11 as being anticipated by US Patent 4,317,816 Arichi et al. ("Arichi"). See the Office Action, page 3, lines 6-7. Applicants disagree. Independent claim 1 will be discussed first.

Claim 1 covers a composition containing an enriched American ginseng extract obtained by extraction, centrifugation, and filtration with an ultrafiltration membrane with a molecular weight cut-off of at least 1,000. All compounds in this American ginseng extract have molecular weights of greater than 1,000.

According to the Examiner, Arichi teaches a composition that "appears to be the same as" the composition of claim 1. It is her position that the Arichi composition can contain at least

one saponin extracted from American ginseng that has a molecular weight of greater than 1,000, and is therefore covered by claim 1.

Note that the Arichi composition is first prepared by extraction with various solvents and then by precipitation in ether. See column 2, lines 24-39. Thus, all of its components are not ether-soluble. In contrast, the composition of claim 1 contains ether-soluble compounds, as shown in a Declaration by Feng-Nien Ko (attached as "Exhibit A"). Specifically, the Declaration describes ether-solubility assays of two compositions of this invention containing extracts prepared according to the procedures described in Examples 1 and 4, respectively, of the Specification. The results show that the two compositions contain 4.8% and 10.0 % ether-soluble compounds, respectively.

Applicants would like to point out that "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention." See MPEP, Section 706.02. As described above, the composition of claim 1 contains ether-soluble compounds, and the Arichi composition does not contain ether-soluble compounds. Arichi therefore fails to "teach every aspect of" claim 1. As such, it does not anticipate claim 1. Neither does it anticipate claims 3, 11, and 23-37, all of which depend from claim 1.

II

The Examiner maintained her rejection against claims 1 and 11 as being anticipated by JP 04316507A ("JP '507"), alleging that the response to the office action of August 27, 2002 ("Response") was not persuasive. More specifically, she asserted that Yoshikawa, an exhibit filed with the Response, "does not seem relevant to the rejection." See the Office Action, page 4, third paragraph.

Applicants disagree, and again will discuss claim 1 first. As pointed out in the Response, Yoshikawa teaches that an American ginseng extract contains a number of compounds having molecular weights of between 1,000 and 10,000. As the composition of claim 1 contains compounds having molecular weights of at least 1,000, it must contain those having molecular weights of between 1,000 and 10,000 taught in Yoshikawa. In contrast, JP '507 teaches an American ginseng extract that contains compounds having molecular weights of greater than 10,000, not those having molecular weights of between 1,000 and 10,000. It therefore does not

anticipate claim 1. Neither does it anticipate claims 3, 11, and 23-37, all of which depend from claim 1.

III

The Examiner also maintained her rejection against claims 1 and 11, relying on JP 61109732A ("JP '732") in the same manner as JP '507. For the same reasons set forth in Part II above, JP '732 does not anticipate claim 1. Thus, claim 1 is novel over JP '732. So are claims 3, 11, and 23-37, all of which depend from claim 1.

CONCLUSION

For the above remarks, Applicants submit that the grounds for rejection asserted by the Examiner have been overcome, and the claims, as pending, define subject matter that is novel. On this basis, it is submitted that allowance of this application is proper, and early favorable action is solicited.

Please apply any other charges to deposit account 06-1050, referencing attorney docket 11544-003001.

Respectfully submitted,

Date: _____

8-6-03



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